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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,917	07/03/2001	Siu-Leong lu	54270-138	3640

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,917

Applicant(s)

IU ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 18 is/are rejected.
- 7) ☒ Claim(s) 2-17 and 19-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

- 121:
1. Restriction to one of the following inventions is required under 35 U.S.C.
 - I. Claims 1-30 are drawn to digital watermarks that obfuscate the digital information; classified in class 705 subclass 57.
 - II. Claims 31-37 are drawn transferring digital data, classified in class 705 subclass 50.
 - III. Claims 38-42 are drawn to transmitting encoded CDMA data, are classified in class 705 subclass 51.
 - IV. Claims 44-61 are drawn to watermarking an MPEG bitstream, classified in class 705 subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as a utilizing CDMA data or an MPEG bitstream. The subcombinations have separate utility such as utilizing CDMA data or an MPEG bitstream.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a serious burden to search all four inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper file on October 20, 2004 the applicant has elected the examination of invention I, directed towards claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claims 1-30 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, (US Patent No 6,363,159) in view of Levine (US Patent 6,320,965).

As per claim 1,

Rhoads ('159) discloses a method for processing an audio or video data stream containing digital watermark data comprising:

altering the audio or video information slightly by applying to the audio or video datastream a predetermined mapping function associated with the playback unit that is different from mapping functions associated with other playback units to internally distort the audio or video content by a small amount not perceptible to the user (Figures 2 and 3)

Such that audio or video information produced by combining multiple audio or video data streams corresponding to said information, from different playback units will be perceptibly distorted(Figures 2 and 3)

Rhoads ('159) does not explicitly disclose "utilizing a playback device for playing out information in the audio or video data stream during the playing by the playback unit,". Levine ('965) discloses "utilizing a playback device for playing out information in the audio or video data stream during the playing by the playback unit,"(Figure 22). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Levine's teaching in order to enforce digital rights management systems.

As per claim 18,

Rhoads ('159) discloses a playback unit, comprising:

means for imparting a prescribed transformation to the video image for intentionally warping the video image in a manner, and by an amount not readily visible to a viewer such that a composite video image produced by multiple playback units will be visibly distorted.(Figures 2 and 3)

Rhoads ('159) does not explicitly disclose "An input for receiving an encoded data stream bearing a video image; a decoder for decoding the encoded video stream".

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Levine ('965) discloses "An input for receiving an encoded data stream bearing a video image; a decoder for decoding the encoded video stream "(Figure 22). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Levine's teaching in order to enforce digital rights management systems.

Allowable Subject Matter

Claims 2-17 and 19-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (763) 872-9306 for regular communications and (763) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
December 26, 2004

JAMES P. TRAMMELL
SUPERVISORY AGENT EXAMINER
ART UNIT 3600